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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,736	01/10/2005	Kazuhiko Takabayashi	09812.0202	9751
22852 7590 04/06/2009 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER SCHWARTZ, DARREN B	
			ART UNIT 2435	PAPER NUMBER
			MAIL DATE 04/06/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/520,736

**Applicant(s)**

TAKABAYASHI ET AL.

**Examiner**

DARREN SCHWARTZ

**Art Unit**

2435

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2009 and 11 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant amends claims 1, 9, 17-20, 23, 24 & 26 and adds new claim 27.

Claims 1-27 are presented for examination.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 March 2009 has been entered.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

The fact that the Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative, should not be construed as indicating Examiner's agreement therewith.

#### ***Claim Objections***

Claims 18-19 are objected to because of the following informalities: the claims recite "a unit configure to receive" and should read "a unit configured to receive."

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-4, 6-12, 14-20 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto (U.S. Pat 6854062 B2), hereinafter referred to as Okamoto, in view of Smith, II et al (U.S. Pat 5884298 A), hereinafter referred to as Smith.

Re claims 1 and 9: Okamoto teaches a device-to-device authentication system for authenticating when devices on a network are connected within a certain range, comprising:

a first device [Fig 1, elt 5: PC] comprising:

a first mediating device interface [Fig 1, elt 6: READER/WRITER] for physically connecting a removable mediating device [Fig 1, elt 4: BRIDGING MEDIUM] (col 3, lines 19-23),

a second device [Fig 1, elt 2 & Fig 3, elt 2: HOUSEHOLD DEVICE] comprising:

a second mediating device interface [Fig 3, elt 25: BRIDGING MEDIUM READER] for physically connecting the removable mediating device [Fig 1, elt 4 & Fig 3, elt 4: BRIDGING MEDIUM] (col 4, lines 53-54),

a network interface unit [Fig 3, elt 24 & "HOUSEHOLD NETWORK"] configured to receive a request for authentication over the network ["HOUSEHOLD NETWORK;" col 4, lines 45-50] (Fig 4, all elts: col 5, lines 8-15).

However, Smith teaches:

local environment management means for authenticating that the first device has physically connected to the removable mediating device within a predetermined period of time before or after the removable mediating device physically connected to the second device (col 33, lines 58 – col 34, line 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Okamoto with the teachings of Smith, for the purpose of calculating usage time of content that has been checked-out.

The combination of Okamoto and Smith teaches: wherein the first device can use content when the first device is authenticated (Okamoto: Fig 1010 & 1011: col 5, lines 51-60).

Re claims 2 and 10: The combination of Okamoto and Smith teaches: the second device is a home server (Okamoto: Fig 3: col 4, lines 16-21), the first device is a client for making a request for the content to the home server and in response to authentication of the client, the home server provides the content and/or issues a license for the content the client (Smith: Fig 2).

Re claims 3 and 11: The combination of Okamoto and Smith teaches: two or more home servers are able to be installed on the network and at least one of the home servers provides the content and/or issues a license for the content to a client that is authenticated (Okamoto: Fig 1, elts 1, 2, 3, & 5; see also Okamoto Fig 1, elts "OUTSIDE NETWORK" and "HOUSEHOLD NETWORK;" Smith: Fig 2; col 1, lines 58-65).

Re claims 4 and 12: The combination of Okamoto and Smith teaches: the client is able to be receive provision of the content and/or issuance of the license from least one of the two or more home servers on the network (Okamoto: Fig 4, elts 1005, 1008, 1009, 1010, 1011 & 1012) (Smith: Fig 2).

Re claims 6 and 14: The combination of Okamoto and Smith teaches the removable mediating device is capable of retaining predetermined identification information for determining that the first and the second device have connected to the removable mediating device within the predetermined period of time (Smith: col 33, lines 58 – col 34, line 8).

Re claims 7 and 15: The combination of Okamoto and Smith teaches the removable mediating device comprises a memory for retaining confidential information, for determining that the first and the second device have connected to the removable mediating device within the predetermined period of time, in a secure manner (Smith: col 43, lines 22-29).

Re claims 8 and 16: The combination of Okamoto and Smith teaches the confidential information is erased after the predetermined period of time elapses (Smith: col 11, lines 38-50).

Re claim 17: Okamoto teaches a communication apparatus for using content on a network within a predetermined allowable range, comprising:

a mediating device interface [Fig 3, elt 25: BRIDGING MEDIUM READER] for physically connecting a removable mediating device [Fig 1, elt 4 & Fig 3, elt 4: BRIDGING MEDIUM] (col 4, lines 53-54),

a network interface [Fig 3, elt 24 & "HOUSEHOLD NETWORK"] for receiving or transmitting a request for authentication over the network ["HOUSEHOLD NETWORK;," col 4, lines 45-50] (Fig 4, all elts: col 5, lines 8-15);

However, Smith teaches:

a local environment management unit configured to authenticate that the apparatus and a device have physically connected to the mediating device within a predetermined period of time between connections, to control the use of the content (col 33, lines 58 – col 34, line 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Okamoto with the teachings of Smith, for the purpose of calculating usage time of content that has been checked-out.

Re claim 18: The combination of Okamoto and Smith teaches: means for providing the content and/or issuing a license for the content when the device and the apparatus are authenticated, wherein the communication apparatus operates as a home server for providing content on the network (Okamoto: col 5, lines 8-37) (Smith: Fig 2).

Re claim 19: The combination of Okamoto and Smith teaches: a unit configure to receive the content and/or a license for the content when the device and the apparatus are authenticated, wherein the communication apparatus operates as a client for making a request for the content to a home server on the network (Okamoto: Fig 2, see at least elts 1002 & 1003; col 5, lines 8-37) (Smith: Fig 2).

Re claim 20: The combination of Okamoto and Smith teaches: the means for receiving receives provision of the content and/or issuance of a license for the contents from the two or more home servers authenticated by the local environment management means (Smith: Fig 2; col 1, lines 58-65).

Re claim 22: The combination of Okamoto and Smith teaches: the removable mediating device is capable of retaining predetermined identification information for determining that the communication apparatus and another device have connected to the removable mediating device within the predetermined period of time (Smith: col 33, lines 58 – col 34, line 8).

Re claim 23: Claim 23 is rejected under similar grounds as those provided in claims 7 and 15.

Re claim 24: The combination of Okamoto and Smith teaches: the local environment management unit authenticates that the another device, which reads same confidential information from the mediating device and/or reads confidential information within a predetermined period of time, is located in the local environment of the local environment management means (Smith: col 33, lines 58 – col 34, line 8).

Re claim 25: Claim 25 is rejected under similar grounds as those provided in claims 6 and 16.

Re claim 26: Okamoto teaches a computer-readable medium storing a program for causing a computer to execute a method for authenticating whether or not devices on a network are connected within a certain scope (col 11, lines 37-48), the method comprising:



receiving a request for authentication over the network (Fig 4, all elts: col 5, lines 8-15);

authenticating that a first device physically connected to a removable mediating device (Fig 4, elts 1001, 1002, 1003, 1004, 1005, 1006 & 1007) allowing the first device to use content when the first device is authenticated (Fig 4, elts 1009, 1010, 1011 & 1012).

However Smith teaches within a predetermined period of time before or after the removable mediating device physically connected to a second device (col 33, lines 58 – col 34, line 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Okamoto with the teachings of Smith, for the purpose of calculating usage time of content that has been checked-out.

2. Claims 5, 13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto (U.S. Pat 6854862 B2), hereinafter referred to as Okamoto, in view of Smith, II et al (U.S. Pat 5884298 A), hereinafter referred to as Smith, in further view of Katsuda et al (U.S. Pat Pub 2003/0046352 A1), hereinafter referred to as Katsuda.

Re claims 5, 13 and 21: The combination of Okamoto and Smith teaches all the limitations of claims 3, 11 and 21 as previously discussed.

Katsuda teaches wherein upon connection to a home server on a second network, the client is not able to use the content from the two or more home servers (entire Abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Okamoto and Smith with the teachings of Katsuda, for the purpose of protecting digital content and disallowing its use outside a designated network, as taught by Katsuda (see Katsuda Abstract).

3. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto (U.S. Pat 6854862 B2), hereinafter referred to as Okamoto, in view of Smith, II et al (U.S. Pat 5884298 A), hereinafter referred to as Smith, in further view of Jinriki et al (JP 2002-281019 A), hereinafter referred to as Jinriki. A translated copy of Jinriki et al., JP 2002-281019 A has been provided with this Office Action.

Re claim 27: The combination of Okamoto and Smith teaches all the limitations of claim 9 as previously discussed.

Jinriki teaches writing a temporary random number to the mediating device (page 5, bottom line – page 6, top line; page 6, lines 4-5; ¶11); reading the temporary random number from the mediating device (page 5, bottom line – page 6, top line; ¶24); and collating the temporary random number (page 5, lines 2-3; page 6, lines 7-8; ¶11; ¶24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Okamoto and Smith with the teachings of Jinriki, for the purpose of authenticating portable devices, as taught by Jinriki (page 1, line 1; page 3, ¶2).

### **Conclusion**

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the text of the passage taught by the prior art or disclosed by the examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARREN SCHWARTZ whose telephone number is (571)270-3850. The examiner can normally be reached on 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S./  
Examiner, Art Unit 2435  
/Nirav Patel/  
Supervisory Patent Examiner, Art Unit 2435